

REMARKS

I. Introduction

Claims 32-70 and 72-78 are pending in this application.

Claims 32-70 and 72-78 are rejected.

Applicants traverse these rejections in view of the remarks set forth below. Applicants respectfully request reconsideration and allowance of the pending claims.

II. Applicants' Reply to Claim Rejections Under 35 U.S.C. § 102

Claims 32, 34, 68, and 69

Claims 32, 34, 68, and 69 are rejected under 35 U.S.C. 102 (b) as being anticipated by U.S. Pat. No. 4,855,725 to Fernandez et al. ("Fernandez"). Applicants respectfully traverse.

Fernandez is purportedly concerned with a portable storage device ("CD book"), which stores several pages of content in its RAM and adds new content by transferring data from a CD-ROM database when the CD book user reaches the last page of the previously stored content or specifically requests a page not currently stored on the device. *See, e.g.,* Fernandez, Abstract; column 2, lines 32-38; column 3, lines 8-24; column 7, lines 35-61; Figs. 2, 4, 5.

In contrast, as specified in independent claim 32, Applicants' invention describes a method including storing in a playback device an episode published at a first time and automatically updating the episode published at the first time with a subsequent episode published at a second time. Applicants respectfully point out that uploading new pages of the same, static book stored in the CD-ROM database when the user reaches the last page or request a new page as discussed in Fernandez is distinctly different from automatically updating the episode with a more recently published episode. CD books described in Fernandez are published at one time and thus do not include any subsequent updates. Even if a whole new edition of a

particular CD book is published, Fernandez does not describe any features related to automatically updating this particular book as its new edition comes out.

Further, as specified in independent claim 34, the applicants' invention describes a method for storing at least one subset of content, which is automatically updated as portions of the subset are *consumed*. For example, a user may specify a first subset of content, which may be an hour long. After a portion (*e.g.*, 20 minutes) of the first subset of content is consumed, that portion of consumed content is automatically updated with 20 minutes of new content ("second subset"), such that the subset once again contains an hour of unconsumed content. Uploading new pages of the same book stored in the CD-ROM database when the user reaches the last page or request a new page as discussed in Fernandez is distinctly different from selectively updating the *consumed* portion of a particular subset of digital content as specified in applicants' claims.

This feature of the applicants' invention allows, among other things, to maximize the memory usage of the playback device and to automatically replenish the content once a portion of it has been consumed. Fernandez does not show or suggest this feature. Moreover, in Fernandez, the user may jump to various pages or to the end of the content without consuming the content, thus teaching away from the claimed invention. *See, e.g.*, Fernandez, column 7, lines 35-45.

Furthermore, as specified in independent claim 68, the applicants' invention describes a method for storing *multiple* subsets of content, each of which may be automatically and independently updated as portions of a particular subset are consumed. For example, a user may specify multiple subsets of content, each of which may be an hour long. After a portion (*e.g.*, 20 minutes) of the first subset of content is consumed, that portion of consumed content is automatically updated with 20 minutes of new content ("second subset"), such that the subset once again contains an hour of unconsumed content. Uploading new pages of the same book

stored in the CD-ROM database when the user reaches the last page or request a new page as discussed in Fernandez is distinctly different from selectively updating the consumed portion of a particular subset of digital content as specified in applicants' claims. This feature of the applicants' invention allows, among other things, to maximize the memory usage of the playback device and to automatically replenish the content once a portion of it has been consumed. Fernandez does not show or suggest this feature. Moreover, in Fernandez, the user may jump to various pages or to the end of the content without consuming the content, thus teaching away from the claimed invention. *See, e.g.,* Fernandez, column 7, lines 35-45.

In rejecting claims 32 and 34, the Examiner relies upon the theory of inherency, contending that "it is inherent that the content is no longer than a predetermined playback time in order to fit in the memory of the playback device." *See* Office Action dated August 12, 2005, at pages 3-4. Applicants respectfully disagree. Fernandez does not disclose that the user of the CD book may select a playback time for an episode or a subset of digital content, as specified in applicants' claims. Instead, the CD book described in Fernandez merely stores several pages of content in its RAM irrespective of a user's preferences. Moreover, Fernandez does not teach or suggest storing different books in the disclosed CD book with the user being able to specify how much memory each book may take.

Furthermore, the mere fact that the content must "fit in the memory of the playback device" is not sufficient to establish that the CD book in Fernandez inherently updates its content so that it is no greater than a predetermined playback time or approximately equal to a playback time of the first subset of digital content, as specified in claims 32 and 34. *See, e.g.,* MPEP 2112.IV. As explained above, Fernandez does not allow the user to specify how much memory each page or a part thereof may take, and even if it did, specifying the *size* of the memory does

not necessarily correlate directly with playback *time*. Therefore, applicants respectfully request that the inherency rejection be withdrawn. Thus, claims 32, 34, 68, and 69 are patentable over Fernandez.

III. Applicants' Reply to Claim Rejections Under 35 U.S.C. §103

Claims 33, 40-64, and 70

Claims 33, 40-64, and 70 are rejected under 35 U.S.C. §103 (a) as being unpatentable over Fernandez. Applicants respectfully traverse.

Applicants submit that claim 33 is allowable for at least the same reason as independent claim 32, as explained above.

As specified in claims 40-64, and 70, applicants' invention describes methods and apparatuses for storing multiple titles, each of which may be automatically and independently updated as portions of a particular title are consumed. For example, a user may specify multiple titles of content, each of which may be an hour long. After a portion (*e.g.*, 20 minutes) of the first title is consumed, that portion of consumed content is automatically updated with 20 minutes of new content. Fernandez does not show or suggest this feature.

Moreover, the Examiner notes that Fernandez does not disclose replacing consumed media according to a user predetermined specification. *See* Office Action dated August 12, 2005, at page 4. Referring to the design choice language in Fernandez, the Examiner contends, however, that "total automation is not always desired." *Id.* at 5. Applicants respectfully point out that in Fernandez the design choice referred to by the Examiner is based on system limitations, for example, transmission rates, microprocessor speed, and/or RAM size. *See, e.g.*, Fernandez, column 7, lines 58-62. This type of design choice and implementation thereof are made by the designer of the system. In contrast, in applicants' invention, the choice is based on a user's

preferences and made by the user. Thus, applicants respectfully submit claims 33, 40-64, and 70 are patentable over Fernandez.

Claims 35-39

Claims 35-39 are rejected under 35 U.S.C. §103 (a) as being unpatentable over U.S. Pat. No. 5,761,485 to Munyan ("Munyan") in view of U.S. Pat. no. 5,918,013 to Mighdoll et. al ("Mighdoll") and U.S. Pat. No. 5,491,820 to Belove et al. ("Belove"). Applicants respectfully traverse.

Claims 35-39 specify a network including a server device, a data retrieval device, and a playback device, the playback device storing a most-recent episode of digital content which is automatically updated with a subsequent episode. Munyan, Mighdoll, and Belove, separately or in combination, fail to teach or suggest this feature:

Munyan is purportedly concerned with an electronic book and an online store and does not disclose or suggest at least a data retrieval device and a playback device. As noted by the Examiner, Munyan does not teach a retrieval device. *See* Office Action at page 7. While Munyan discusses how additional material can be downloaded from a remote server when manually selected by the user, Munyan also explains that old material must be manually deleted by the user to make room for new materials. *See, e.g.*, Munyan, column 5, lines 59-65; column 8, lines 5-14. Thus, Munyan teaches away from applicants' claimed invention in this regard. Nowhere does Munyan disclose or suggest that an episode is automatically updated with a subsequent episode. Thus, the Personal Electronic Book described in Munyan is distinctly different from the playback device because it does not store a most-recent episode of digital content which is automatically updated with a subsequent episode.

Mighdoll is purportedly concerned with a WebTV network, in which a number of WebTV clients are connected to a WebTV proxy server, and does not disclose or suggest at least a data retrieval device and a playback device specified in claims 35-39. *See, e.g.*, Mighdoll, Abstract, column 4, line 40-column 5, line 27; column 11, line s 42- column 12, line 9; Figs. 1, 4A. The WebTV server described in Mighdoll caches the frequently requested information to reduce latency in providing Web pages to the client and also automatically transcodes requested information to ensure compatibility with the clients' systems. *See id.* The WebTV server and its proxy cache are different from the data retrieval device because the WebTV server is not part of a client-side system.

Belove is purportedly concerned with storage and transmission of retrievable items in a client-server computer environment and does not disclose or suggest at least a playback device specified in claims 35-39. At most, Belove discusses an apparatus for selective data transfer from a central server computer to a plurality of client computers, which provides means for downloading most up-to-date copies of folders stored on a client computer either at the beginning of the session for all folders or only in response to the user's selection of a particular folder. Nowhere Belove disclose or suggest a "playback device to store and to play back the digital content coupled with the data retrieval device." The client described in Belove is different from the playback device because the client is not coupled to a data retrieval device (but to a server) and does not play back.

Thus, none of these three references disclose or suggest at least a playback device.

Moreover, applicants respectfully submit that there is no motivation to combine these multiple references as suggested by the Examiner. With respect to a motivation to combine, the Examiner states:

“Hence, it would have been obvious for one of ordinary skill in the art to combine the teaching of Mighdoll with Munyan because it would have improved the transmission efficiency and latency in providing content to the playback device”

“Hence, it would have been obvious for one of ordinary skill in the art to combine the teaching of Belove to Munyan because it would have provided for automatic updating content on the playback device according to the user specification.”

See Office action, at pages 7-8. However, applicants note that these contentions merely state that the combination is obvious without providing any reason or motivation to actually make the proposed combination. No motivation to combine is provided in the references themselves. Thus, applicants respectfully submit that the Examiner is employing impermissible hindsight reconstruction in an attempt to force a combination of otherwise unrelated references based upon the teachings of applicants' disclosure. See *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887 (Fed. Cir. 1988). Thus, claims 35-53 are patentable over Munyan, Mighdoll, and Belove.

Claims 65-67 and 72-78

Claims 65-67 and 72-78 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,442,390 to Hooper et al. (“Hooper”). Applicants respectfully traverse.

The Examiner notes that Hooper does not teach storing multiple content selections, as specified in claims 65-67 and 72-78. See Office Action at page 9. In an effort to produce this feature, the Examiner takes Official Notice that

“It would have been obvious for one of ordinary skill in the art to store multiple content selections in Hooper because it would have enabled the viewer have immediate access to multiple contents without having to repeat the process locating and requesting the selection from the server.”

See id. Applicants respectfully submit that neither Hooper nor the Examiner's Official Notice or any combination thereof shows or suggests this feature.

For example, Hooper is purportedly concerned with a video-on-demand system, in which a selected video is transferred as video segments and stored in a memory buffer ("segment cache"), which includes a write pointer ("fill pointer") and a read pointer ("play pointer"). *See, e.g.,* Hooper, Abstract, column 2, lines 1-7; column 9, lines 45-48. The total number of video segments stored in the cache is fixed and depends on the type of the video. By fixing the number of segments, the Hooper system limits the number of broadcast streams with a customer waiting for certain time to start viewing the selected video. *See id.* at column 10, lines 9-29. While a server-side segment cache in Hooper may include multiple fill-pointers and play-pointers, these pointers are used to synchronize multiple customers accessing a single content selection, *i.e.,* the same video, and minimize the number of broadcast streams. *See id.* at column 11, lines 6-17; column 12, line 52-column 13, line 27; Figs. 9, 10.

In sharp contrast to Hooper, claims 65-67 specify a playback device including a memory to store *multiple* digital content selections, a logic to maintain a head pointer identifying a logical beginning of *each* selection in memory, and a content counter. Hooper discloses none of these features. A segment cache in Hooper does not and cannot store multiple content selections; at most, it can only store several adjacent segments of the same digital selection. Hooper provides no teaching describing how to store and render segments relating to different selections in the same segment cache. Further, because fill pointers and play pointers in Hooper are designed to synchronize multiple users accessing the same selection, fill/play-pointers are neither head pointers nor content counters.

Furthermore, Hooper provides no teaching describing how to accomplish the modification required to provide the combination proposed by the Examiner. For example, additional hardware, software, data management protocols or procedures would be necessary to effect such a modification; neither of which is shown or suggested by Hooper. For example, a server cache described in Hooper needs to be modified to be able to store multiple content selections. Hooper does not teach or suggest how to effect such a modification. Additional controller(s) and corresponding logic would be needed to effect a content counter. Hooper does not show or suggest such a content counter or how to effect such a modification either.

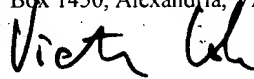
Moreover, Hooper fails to recognize the problem solved by this feature of the applicants invention. In addition, a mere assertion that the modifications of the prior art necessary to meet the claimed invention were separately known to one skilled in the art at the time the invention was made is insufficient to support a finding of obviousness. *See Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). Thus, applicants respectfully request that the rejection of claims 65-67 and 72-78 be withdrawn.

IV. Conclusion

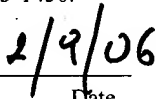
For the foregoing reasons, applicants respectfully submit that the invention as claimed is patentable over the references cited by the Examiner. Accordingly, reconsideration and allowance of pending claims 32-70 and 72-78 are respectfully requested. The Examiner is encouraged to contact applicants' undersigned representative to discuss any matter that may expedite prosecution of this case.

Dated: February 9, 2006

I hereby certify that the correspondence attached herewith is being deposited this date with the U.S. Postal Service as Express Mail Mailing Label No. EV446919728US, with sufficient postage addressed to the Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.

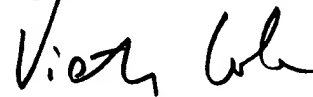


Victor Cole



Date

Respectfully submitted,



Victor Cole
Reg. No. 56,331
BROWN RAYSMAN MILLSTEIN
FELDER & STEINER LLP
900 Third Avenue
New York, New York 10022
Tel : (212) 895-2000
Fax: (212) 895-2900